

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

In re Patent Application of

NAKAI et al.

Serial No. 09/833,651

Filed: April 13, 2001

Title: PRINT CONTROL OPERATION SYSTEM USING ICONS

Atty Dkt. JAR-1275-44

C# M#

TC/A.U.: 2173

Examiner: Pillai, Namitha

Date: November 19, 2007



1/2

AP

**Mail Stop Appeal Brief - Patents**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

☐ **Correspondence Address Indication Form Attached.**

☐ **NOTICE OF APPEAL**

Applicant hereby **appeals** to the Board of Patent Appeals and Interferences

from the last decision of the Examiner twice/finally rejecting

\$500.00 (1401)/\$250.00 (2401) \$

applicant's claim(s).

☒ **In response to the Notification of Non-Compliant Appeal BRIEF dated November 14, 2007, attached is an Appeal Brief for the above-identified application**

\$500.00 (1402)/\$250.00 (2402) \$ 0.00

☐ Credit for fees paid in prior appeal without decision on merits -\$ ( )

☐ A reply brief is attached. (no fee)

☐ Petition is hereby made to extend the current due date so as to cover the filing date of this paper and attachment(s)

One Month Extension	\$120.00 (1251)/\$60.00 (2251)
Two Month Extensions	\$450.00 (1252)/\$225.00 (2252)
Three Month Extensions	\$1020.00 (1253)/\$510.00 (2253)
Four Month Extensions	\$1590.00 (1254)/\$795.00 (2254) \$

☐ "Small entity" statement attached.

Less month extension previously paid on -\$ ( )

**TOTAL FEE ENCLOSED \$ 0.00**

Any future submission requiring an extension of time is hereby stated to include a petition for such time extension. The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our **Account No. 14-1140**. A duplicate copy of this sheet is attached.

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Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPEAL BRIEF**

Sir:

Appellant hereby appeals to the Board of Patent Appeals and Interferences from the last  
decision of the Examiner.

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(I) **REAL PARTY IN INTEREST**

The real party in interest is Sharp Kabushiki Kaisha, a corporation of the country of Japan.

**(II) RELATED APPEALS AND INTERFERENCES**

The appellant, the undersigned, and the assignee are not aware of any related appeals, interferences, or judicial proceedings (past or present), which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

**(III) STATUS OF CLAIMS**

Claims 1-11 are pending and have been rejected. Claim 9 has been allowed. Thus, claims 1-8 and 10-11 are on appeal herein.

**(IV) STATUS OF AMENDMENTS**

No amendments have been filed since the date of the Final Rejection.

**(V) SUMMARY OF CLAIMED SUBJECT MATTER**

This section is for purposes of example only and without limitation.

Claim 1 relates to a print control operation system. In certain example embodiments, the print control operation system of claim 1 uses icons including a display picture for displaying a print icon having predetermined print conditions and a file icon of a file to be printed (e.g., pg. 4, lines 5-8 and 21), print processing of said file being executed under the predetermined print conditions in said print icon by dragging said file icon and dropping the file icon on the print icon (e.g., pg. 4, lines 8-11; pg. 17, lines 21-23; pg. 9, line 24 to pg. 11, line 2; Figs. 1A-1B). In certain example embodiments, the print icon is formed so that the display is altered according to a setting of the print conditions in the print icon (e.g., pg. 11, lines 5-24; pg. 12, line 13 to pg. 13, line 17), and the print conditions are displayed on the display picture in a recognizable display form when the file icon is not located over the print icon (e.g., page 11, lines 6-24; pg. 4, lines 11-13; pg. 17, lines 17-21; and Fig. 2). The print icon to which the file icon is dragged and dropped is an icon which limits on a specific function among print processing functions provided in a corresponding printer (e.g., pg. 5, line 13 to pg. 6, line 9; pg. 7, lines 15-25; pg. 11, lines 9-24; ), and which issues a print command by a function which specifies the file icon for the printer when the file icon is dragged and dropped on the print icon. In certain example embodiments, the print icon can be generated on a screen of the display as a printer icon which is capable of directly designating at least one frequently used function among print processing functions possessed by the printer (e.g., pg. 6, lines 10-25; pg. 12, lines 1-25; pg. 15, lines 5-13; and pg. 17, lines 21-23).

Claim 3 relates to a print control operation system. The print control operation system uses icons including a display picture for displaying a print icon having predetermined print conditions and a file icon of a file to be printed (e.g., pg. 4, lines 5-8 and 21). In certain example embodiments, print processing of the file being executed under the predetermined print



conditions is performed by at least dragging the file icon and dropping it on the print icon (e.g., pg. 4, lines 8-11; pg. 17, lines 21-23; pg. 9, line 24 to pg. 11, line 2; Figs. 1A-1B). In certain example embodiments, the print conditions in the print icon are displayed on the display picture in a recognizable display form (e.g., page 11, lines 6-24; pg. 4, lines 11-13; pg. 17, lines 17-21; Fig. 2). At a time point when a file icon of a file to be printed is superposed on the print icon, a printing preview of the file icon's associated file to be printed is displayed on the display picture (e.g., pg. 4, lines 21-25; pg. 18, lines 9-15; and Figs. 7, 11). As shown in Figs. 7 and 11 for example, a "printing preview" as called for in claim 3 is an image of at least part of what is going to be printed. This is advantageous, for example, in that it permits a user to view and confirm contents of a file to be printed without having to open the file on an application (e.g., pg. 18, lines 12-15).

Claim 8 requires "a printer to be used is set in said print icon as one of set conditions of said print icon, a state of said printer is monitored in said print control operation system, and *when said printer is in such a state that said printer cannot execute processing set in said print icon, said print icon is controlled so as not to be displayed.*" For example, see the instant specification at page 19, line 19 to page 20, line 1. See also page 16, lines 5-15. For example, it is explained on page 16 of the instant specification that "[i]n this case, however, the state of a printer set in each print icon is confirmed, and a print icon of a printer that cannot conduct processing is prevented from being displayed. For example, if staple processing is set in a print icon and the set printer staple runs out, then the print icon is not displayed. Also in the case where the power supply of a set printer is not on, the print icon is not displayed. Or it is also possible to conduct gray-out display of a print icon that cannot be processed and explicitly indicate that the function is inhibited."

**(VI) GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

(i) Whether claims 3, 5-8 and 11 are unpatentable under Section 103(a) over Fitzpatrick (US 5,546,527).

(ii) Whether claim 4 is unpatentable under Section 103(a) over Fitzpatrick (US 5,546,527) in view of Hemenway (US 5,638,505).

(iii) Whether claim 1 is unpatentable under Section 112, first paragraph, in view of the written description requirement.

(iv) Whether claims 1, 2 and 10 are unpatentable under Section 103(a) over Fitzpatrick (US 5,546,527) in view of Hemenway (US 5,638,505).

## (VII) ARGUMENT

It is axiomatic that in order for a reference to anticipate a claim, it must disclose, teach or suggest each and every feature recited in the claim. See, e.g., *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983). The USPTO has the burden in this respect.

Moreover, the USPTO has the burden under 35 U.S.C. Section 103 of establishing a *prima facie* case of obviousness. *In re Piasecki*, 745, F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). It can satisfy this burden only by showing that some objective teaching in the prior art, or that knowledge generally available to one of ordinary skill in the art, would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Before the USPTO may combine the disclosures of the references in order to establish a *prima facie* case of obviousness, there must be some suggestion for doing so. *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992). Even assuming, *arguendo*, that a given combination of references is proper, the combination of references must in any event disclose the features of the claimed invention in order to render it obvious.

Furthermore, with respect to the inherency rejections, the law is clear that for something to be “inherent” in a reference, it must “necessarily” be present. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The fact that a certain result or characteristic “may” occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). The Board of Appeals has made clear that “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

(i) Whether claims 3, 5-8 and 11 are unpatentable under §103(a) over Fitzpatrick

Claim 3 stands rejected under Section 103(a) as being allegedly unpatentable over Fitzpatrick. This Section 103(a) rejection is incorrect and should be reversed for at least the following reasons.

Claim 3 requires that “*at a time point when a file icon of a file to be printed is superposed on said print icon, a printing preview of the file icon’s associated file to be printed is displayed on said display picture.*” For example, see the instant specification at pg. 4, lines 20-25; pg. 18, lines 9-15; and Figs. 7 and 11. As shown in Figs. 7 and 11 for example, a "printing preview" as called for in claim 3 is an image of at least part of what is going to be printed. This is advantageous, for example, in that it permits a user to view and confirm contents of a file to be printed without having to open the file on an application (e.g., pg. 18, lines 12-15).

Fitzpatrick fails to disclose or suggest the aforesaid quoted aspect of claim 3. A "printing preview" as called for in claim 3 is an image of at least part of what is going to be printed as shown in Figs. 7 and 11. Fitzpatrick does not display such a printing preview of the file icon when the file icon is superposed on the print icon. There is nothing in Fitzpatrick even remotely related to this aspect of claim 3. Thus, the Section 103(a) rejection of claim 3 is incorrect and should be withdrawn.

Claim 8 requires "a printer to be used is set in said print icon as one of set conditions of said print icon, a state of said printer is monitored in said print control operation system, and *when said printer is in such a state that said printer cannot execute processing set in said print icon, said print icon is controlled so as not to be displayed.*" Again, the cited art fails to disclose or suggest this aspect of claim 8. There is nothing in the art of record which would have led one of ordinary skill to the invention of claim 8. There is clearly no prima facie case of obviousness in this respect.

(ii) Whether claim 4 is unpatentable under §103(a) over Fitzpatrick in view of Hemenway

Claim 4 stands rejected under Section 103(a) as being allegedly unpatentable over Fitzpatrick. This Section 103(a) rejection is incorrect and should be reversed for at least the following reasons.

Claim 4 defines over the cited art, at least for the reasons set forth above in connection with claim 3 because claim 4 depends from claim 3.

(iii) Whether claim 1 is unpatentable under Section 112, first paragraph

Claim 1 stands rejected under Section 112, first paragraph, in section 2 of the final Office Action. The Office Action Examiner contends that “when the file icon is not located over the print icon” is not supported by the instant specification. This Section 112 is respectfully traversed and should be reversed for at least the following reasons.

Claim 1 requires that print conditions are displayed on the display picture in a recognizable display form when the file icon is not located over the print icon. Fig. 2 and the instant application at page 11, lines 6-24, clearly illustrate and describe an example where print conditions are displayed in a recognizable form when the file icon is not located over the print icon. Thus, the instant specification supports this claims, and this Section 112, first paragraph, rejection should be withdrawn.

Moreover, during an Interview on October 31, 2006, the Examiner made clear that the Examiner is relying on the fact that the word “not” is not set forth in the instant specification as originally filed (in the context of print conditions being displayed when the file icon is “not” located over the print icon as recited in claim 1). However, this does not mandate a rejection. Fig. 2 and the corresponding specification portions illustrate print conditions being displayed when the file icon 12 is not located over the print icon 11. Thus, the claim is supported and the Section 112 rejection should be withdrawn.

(iv) Whether claims 1, 2 and 10 are unpatentable under Section 103(a) over Fitzpatrick

in view of Hemenway

Claim 1 stands rejected under 35 U.S.C. Section 103(a) as being allegedly unpatentable over Fitzpatrick in view of Hemenway. This Section 103(a) rejection is respectfully traversed and should be reversed for at least the following reasons.

Claim 1 requires that "the print icon is formed so that the display is altered according to a setting of the print conditions in said print icon, and said print conditions are displayed on said display picture in a *recognizable display form* when the file icon is not located over the print icon . . . . the print icon to which the file icon is dragged and dropped is an icon which limits on a specific function among print processing functions provided in a corresponding printer, and which issues a print command by a function which specifies the file icon for the printer when the file icon is dragged and dropped on the print icon, and wherein *the print icon can be generated on a screen of the display as a printer icon which is capable of directly designating at least one frequently used function among print processing functions possessed by the printer.*" Since print conditions may be displayed in accordance with a shape of a printer icon, when a document file is made dragging and dropping onto a printer icon, the printing conditions can be recognized without a particular operation such as hovering so that efficiency and convenience can be significantly improved in certain example embodiments of this invention. Moreover, in certain example embodiments of this invention, the print icon can be prepared to be a print icon capable of issuing a printer order by designating a desired function(s) among print processing functions which are possessed by the printer. The cited art fails to disclose or suggest the aforesaid quoted features of claim 1.

Fitzpatrick discloses a technique related to issuing printer orders of a file to a printer by dropping a dragged file icon by a mouse operation, onto a print icon. When the file icon is superposed on the print icon, a window picture for parameter setting is displayed so that it becomes possible to identify the print conditions.

However, claim 1 requires that *the print icon can be generated on a screen/desktop as a printer icon which is capable of directly designating at least one frequently used function among print processing functions possessed by the printer*. Fitzpatrick (and Hemenway) fails to disclose or suggest this feature. In particular, the print icon of claim 1 can be generated/prepared on an operating screen/desktop as a print icon capable of issuing a print order(s) by directly designating an often-utilized function(s) among print processing functions/features possessed by the printer. This is advantageous, for example, in that the user can optionally generate the icon by selecting a frequently utilized function(s) among print processing functions possessed by the printer. In contrast, Fitzpatrick fails to disclose or suggest that the print icon can be generated as required by claim 1. It is unclear how the print icon of Fitzpatrick is prepared. For example, if Fitzpatrick's print icon were prepared beforehand by a vendor who provided the print system, it would not be possible to generate the print icon on a desktop/screen which would be frequently used by a user.

Thus, even the alleged combination (which applicant believes would be incorrect in any event) still fails to meet the invention of claim 1.

Furthermore, Fitzpatrick discloses that a dragged document icon is hovered over a print icon for a few seconds. By continued hovering of the document icon over/on the print icon, a dialog box for altering print conditions is displayed. Thus, Fitzpatrick discloses that print conditions are displayed when a certain operation is made on a printer icon, but that print conditions cannot be recognized unless the operation is carried out. In particular, in Fitzpatrick print conditions are displayed *only* when such hovering over/on the print icon is performed. Accordingly, it can be seen that Fitzpatrick *fails* to disclose or suggest that print conditions are displayed on said display picture in a *recognizable display form when the file icon is not located over the print icon* as required by claim 1. Instead, Fitzpatrick teaches directly away from this aspect of claim 1 and cannot render the same unpatentable. In this respect, Hemenway also fails

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to disclose or suggest that "print conditions are displayed on said display picture in a *recognizable display form* when the file icon is not located over the print icon" as required by claim 1. Hemenway discloses that print conditions are displayed on a different window; hence it is very inconvenient for recognizing when dragging and dropping is carried out. Since both cited references fail to disclose or suggest at least the "recognizable display form" aspect of claim 1, then even the alleged combination (which is incorrect in any event) fails to meet the invention of claim 1 for this additional reason.

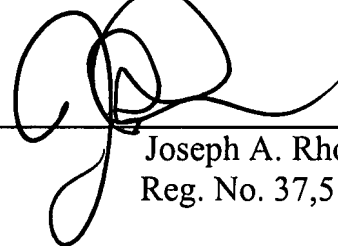
### **CONCLUSION**

In conclusion it is believed that the application is in clear condition for allowance; therefore, early reversal of the Final Rejection and passage of the subject application to issue are earnestly solicited.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

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(VIII) CLAIMS APPENDIX

1. A print control operation system comprising:

the print control operation system using icons including a display picture for displaying a print icon having predetermined print conditions and a file icon of a file to be printed, print processing of said file being executed under the predetermined print conditions in said print icon by dragging said file icon and dropping said file icon on said print icon,

wherein the print icon is formed so that the display is altered according to a setting of the print conditions in said print icon, and said print conditions are displayed on said display picture in a recognizable display form when the file icon is not located over the print icon, and

wherein the print icon to which the file icon is dragged and dropped is an icon which limits on a specific function among print processing functions provided in a corresponding printer, and which issues a print command by a function which specifies the file icon for the printer when the file icon is dragged and dropped on the print icon, and wherein the print icon can be generated on a screen of the display as a printer icon which is capable of directly designating at least one frequently used function among print processing functions possessed by the printer.

2. A print control operation system using icons according to claim 1, wherein at a time point when a file icon of a file to be printed is superposed on said print icon, an outline of the print conditions preset in said print icon is displayed on said display picture.

3. A print control operation system using icons including a display picture for displaying a print icon having predetermined print conditions and a file icon of a file to be printed, print processing of said file being executed under the predetermined print conditions in said print icon by dragging said file icon and dropping said file icon on said print icon,

wherein the print conditions in said print icon are displayed on said display picture in a recognizable display form, and

wherein at a time point when a file icon of a file to be printed is superposed on said print icon, a printing preview of the file icon's associated file to be printed is displayed on said display picture.

4. A print control operation system using icons according to claim 3, wherein when a plurality of file icons of files to be printed are dragged and dropped on said print icon, these files are consecutively subject to print processing as a series of recorded matters.

5. A print control operation system using icons according to claim 3, wherein when a file icon of a file to be printed is dragged and dropped on said print icon, a window for setting print conditions of said print icon is opened.

6. A print control operation system using icons according to claim 3, wherein when a file icon is dragged and dropped on said print icon, a printer capable of conducting print processing is automatically selected based on print conditions set in said print icon.

7. A print control operation system using icons according to claim 6, wherein when a file icon is dragged and dropped on said print icon, a printer capable of conducting print processing is automatically selected from among printers in a stand-by state, based on print conditions set in said print icon.

8. A print control operation system using icons according to claim 6, wherein a printer to be used is set in said print icon as one of set conditions of said print icon,

a state of said printer is monitored in said print control operation system, and  
when said printer is in such a state that said printer cannot execute processing set in said  
print icon, said print icon is controlled so as not to be displayed.

9. (Allowed – Not on Appeal) A print control operation system using icons including a  
display picture for displaying a print icon having predetermined print conditions and a file icon  
of a file to be printed, print processing of said file being executed under the print conditions  
predetermined in said print icon by dragging said file icon and dropping said file icon on said  
print icon,

wherein said print control operation system is formed so as to create a print icon having  
new print conditions set therein, when a predetermined plurality of print icons displayed on said  
display screen and respectively having different print conditions are coupled.

10. A print control operation system using icons according to claim 1, wherein at a time  
point when a file icon of a file to be printed is superposed on said print icon, a printing preview  
of the file icon is displayed on said display picture.

11. The print control operation system of claim 3, wherein the printing preview allows a  
user to view and confirm contents of a file to be printed without having to open the file on an  
application.

**(IX) EVIDENCE APPENDIX**

None

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**(X) RELATED PROCEEDINGS APPENDIX**

None